

ESTTA Tracking number: **ESTTA607636**Filing date: **06/02/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Merit Healthcare International, Inc. dba Merit Pharmaceutical		
Entity	Corporation	Citizenship	California
Address	2611 San Fernando Road San Fernando, CA 90065 UNITED STATES		

Attorney information	Thomas J. Daly Christie, Parker & Hale, LLP P.O. Box 29001 Glendale, CA 91209-9001 UNITED STATES pto@cph.com Phone:626-795-9900
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Registrations Subject to Cancellation

Registration No	1526710	Registration date	02/28/1989
Registrant	MERIT MEDICAL SYSTEMS, INC. #7 79 WEST 4500 SOUTH SALT LAKE CITY, UT 84107 UNITED STATES		

Goods/Services Subject to Cancellation

Class 010. First Use: 1988/03/28 First Use In Commerce: 1988/03/28
All goods and services in the class are cancelled, namely: MEDICAL DEVICES, NAMELY, CORONARY CONTROL SYRINGES AND INTRAVENOUS FLUID DELIVERY COMPONENTS

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)		
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14		
Registration No	4413590	Registration date	10/08/2013
Registrant	Merit Medical Systems, Inc. Legal Department South Jordan, UT 84095 UNITED STATES		

Goods/Services Subject to Cancellation

Class 010. First Use: 1988/03/28 First Use In Commerce: 1988/03/28

All goods and services in the class are cancelled, namely: House mark for catheters, guidewires, syringes and medical accessories used therewith in the fields of cardiology, radiology, surgery, oncology and endoscopy
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Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MERIT		
Goods/Services	Distibution and sale of a variety of pharmaceutical and related products, including syringes, intravenous administration devices, and various intravenous therapy items		

Attachments	M1132-110-2-1_Cancellation.pdf(176339 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Thomas J. Daly/
Name	Thomas J. Daly
Date	06/02/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration Nos. 1,526,710 and 4,413,590
For the Marks Merit and Merit Medical
Dates registered: February 28, 1989 and October 8, 2013

Merit Healthcare International, Inc. dba Merit
Pharmaceutical

Petitioner,

v.

Merit Medical Systems, Inc.

Respondent.

Cancellation No. _____

**COMBINED PETITIONS FOR
CANCELLATION**

Petitioner Merit Healthcare International, Inc. dba Merit Pharmaceutical, a corporation organized and existing under the laws of the State of California, having a principal place of business at 2611 San Fernando Rd., Los Angeles, California 90065 (hereinafter "Petitioner"), believes that it is being damaged and will continue to be damaged by Registration Nos. 1,526,710 and 4,413,590 of Merit Medical Systems, Inc. (hereinafter "Respondent") and hereby petitions to cancel these registrations.

As grounds for the combined petitions for cancellation, Petitioner alleges:

1. Respondent is the listed owner of United States Trademark Registration No. 1,526,710 for MERIT for "medical devices, namely, coronary control syringes and intravenous fluid delivery components" in International Class 010, with a filing date of July 11, 1988, a registration date of February 28, 1989, and an alleged date of first use in commerce of March 28, 1988 ("the '710 Registration").
2. Respondent is the listed owner of United States Trademark Registration No. 4,413,590 for MERIT MEDICAL for "House mark for catheters, guidewires, syringes and medical accessories used therewith in the fields of cardiology,

radiology, surgery, oncology and endoscopy" in International Class 10, with a filing date December 12, 2012, a registration date of October 8, 2013, and an alleged date of first use in commerce of March 28, 1988 ("the '590 registration").

3. On April 22, 2013, Petitioner filed United States Trademark Application Serial No. 85910467 for MERITPHLO for "Medical apparatus, namely, needle venipuncture infusion and injection devices for administering drugs, namely, butterfly sets, butterfly infusion sets, intravenous infusion sets, scalp vein sets, and winged infusion sets, composed of tubing attached to patient needles, for use by general healthcare providers" in International Class 010 ("the '467 Application").
4. The '710 Registration and the '590 Registration have both been cited by the United States Patent and Trademark Office ("USPTO") as reasons to deny approval of Petitioner's '467 Application.

**First Ground for Cancellation
Petitioner's Prior Trademark Rights**

5. Since 1977, Petitioner has been continuously engaged in the distribution and sale of a variety of pharmaceutical and related products, including syringes, intravenous administration devices, and various intravenous therapy items.
6. Since long prior to Respondent's asserted date of first use of the MERIT and MERIT MEDICAL marks in 1988, Petitioner has continuously and extensively used in commerce the mark MERIT in connection with its professional healthcare products, including pharmaceutical and related medical devices and products. Thus, Petitioner has acquired a valid right by use of that mark and trade name continuing from a date prior to the date of registration of the registered marks.
7. Petitioner, through the continuous use and promotion of its MERIT mark over a long period of time and by virtue of the quality of goods sold under this mark, has established valuable goodwill and reputation in connection with the MERIT mark that is jeopardized by Respondent's use and registration of the MERIT and

MERIT MEDICAL marks in Registration Nos. 1,526,710 and 4,413,590, respectively.

8. The goods for which Respondent has registered its MERIT mark, namely, "medical devices, namely, coronary control syringes and intravenous fluid delivery components," are identical or closely related to the goods Petitioner has continuously sold and distributed under its MERIT mark.
9. The goods for which Respondent has registered its MERIT MEDICAL mark, namely, "catheters, guidewires, syringes and medical accessories used therewith in the fields of cardiology, radiology, surgery, oncology and endoscopy," are identical or closely related to the goods Petitioner has continuously sold and distributed under its MERIT mark.
10. Respondent's MERIT mark is identical to Petitioner's mark previously used in commerce by Petitioner and not abandoned as to be highly likely, when applied to the goods of Respondent, to cause confusion or to cause mistake or to deceive. Thus, the mark is being used by the registrant so as to misrepresent the source of the goods on or in connection with which the mark is used.
11. Respondent's MERIT MEDICAL mark so resembles Petitioner's MERIT mark, previously used in commerce by Petitioner and not abandoned, as to be likely, when applied to the goods of Respondent, to cause confusion or to cause mistake or to deceive as to the affiliation, connection, or association of Respondent with Petitioner, or as to the origin, sponsorship, or approval of Respondent's goods by Petitioner under Lanham Act § 2(d) (15 U.S.C. § 1052(d)). Thus, the mark is being used by the registrant so as to misrepresent the source of the goods on or in connection with which the mark is used.
12. Petitioner believes it has been, and will continue to be, damaged by the continued registration of the MERIT and MERIT MEDICAL marks of Respondent for the goods set forth in Registration Nos. 1,526,710 and 4,413,590.

**Second Ground for Cancellation
Fraud on the USPTO**

13. Respondent is not entitled to the continued registration of the '710 and '590 Registrations because Respondent committed fraud on the USPTO in the procurement of both of these registrations.
14. Petitioner alleges on information and belief that Respondent or its agent made false representations of material facts to the USPTO during the prosecution of the applications that resulted in the '710 and '590 Registrations that Respondent knew or should have known were false.
15. On information and belief, the fraud was committed when Respondent filed the required Statement of Use for these registrations alleging that it was using the subject mark of the '710 and '590 Registrations on all of the goods identified in each of the corresponding applications when Respondent knew or should have known it was not using the mark in association with all of the goods.
16. On information and belief, Respondent or its agent made the above-identified false statements with the intent to induce the USPTO to grant the '710 and '590 Registrations, and that the USPTO, incorrectly relying upon the assumed truth of these false material statements, did in fact grant the '710 and '590 Registrations to Respondent.
17. The above-described acts of Respondent or its agent constitute fraudulent procurement of Respondent's '710 and '590 Registrations under Lanham Act § 14 (3) (15 U.S.C. § 1064(3)) and/or Lanham Act § 33 (b)(1) (15 U.S.C. § 1115(b)(1)).
18. Plaintiff has been and will continue to be damaged by the continued registration of Respondent's '710 and '590 Registrations, which have prevented Petitioner from registering its MERITPHLO mark.

**Third Ground for Cancellation
Falsely Suggesting a Connection with Petitioner**

19. The goods covered by Respondent's MERIT and MERIT MEDICAL registrations, including intravenous fluid delivery components and catheters, are identical or closely related to the goods Petitioner has continuously sold and distributed under its MERIT mark since long prior to Respondent's asserted date of first use of the MERIT and MERIT MEDICAL marks in 1988.
20. Respondent's MERIT mark is identical to Petitioner's mark previously used in commerce by Petitioner and not abandoned as to be highly likely, when applied to the goods of Respondent, to falsely suggest a connection with Petitioner.
21. Respondent's MERIT MEDICAL mark so resembles Petitioner's MERIT mark, previously used in commerce by Petitioner and not abandoned, as to be likely, when applied to the goods of Respondent, to falsely suggest a connection with Petitioner.
22. The use of the word MERIT in Respondent's MERIT and MERIT MEDICAL registrations points uniquely and unmistakably to Petitioner Merit Pharmaceuticals because the word MERIT is a significant element of Petitioner's name.
23. Petitioner Merit Pharmaceuticals is not affiliated or otherwise connected with the activities performed by Respondent under Respondent's MERIT and MERIT MEDICAL marks.
24. The fame and reputation of Petitioner is such that when Respondent uses Respondent's MERIT and MERIT MEDICAL on the goods recited in these registrations, a connection with Petitioner Merit Pharmaceuticals is presumed.
25. The above-described acts of Respondent falsely suggest a connection with Petitioner under Lanham Act § 2(a) (15 U.S.C. § 1052(a)).
26. Petitioner has been and will continue to be damaged by the continued registration of Respondent's MERIT and MERIT MEDICAL registrations and Respondent's

use of these registrations in a manner falsely suggesting a connection with
Petitioner.

WHEREFORE, Petitioner prays that these combined petitions for cancellation be granted
and that United States Trademark Registration Nos. 1,526,710 and 4,413,590 be cancelled.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

DATED: June 2, 2014

By TH J Daly

Thomas J. Daly
Attorneys for Petitioner
P.O. Box 29001
Glendale, CA 91209-9001
(626) 795-9900

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CERTIFICATE OF TRANSMISSION AND SERVICE

I certify that on June 2, 2014 the foregoing **COMBINED PETITIONS FOR CANCELLATION** is being electronically transmitted to:

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

It is further certified that on June 2, 2014, the foregoing **COMBINED PETITIONS FOR CANCELLATION** is being served by first class mail to:

Rashelle Perry
MERIT MEDICAL SYSTEMS, INC.
Legal Department
1600 West Merit Parkway
South Jordan, UT 84095

By 
Raymond W. Oo
Christie, Parker & Hale, LLP
P.O. Box 29001
Glendale, CA 91209-9001

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